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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
08/776,578	02/03/97	HARREUS A	R45073

HM11/0605

KEIL & WEINKAUF
1101 CONNECTICUT AVE., N.W.
WASHINGTON DC 20036

EXAMINER	
O SULLIVAN,P	
ART UNIT	**PAPER NUMBER**
1621	

DATE MAILED: 06/05/98

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary	Application No. 08/776,578	Applicant(s) Harreus et al.
	Examiner Peter O'Sullivan	Group Art Unit 1621

☐ Responsive to communication(s) filed on _____ .

☐ This action is **FINAL.**

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) *11-17* is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) *11-17* is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐approved ☐disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) _____ .

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____ .

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☒ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

1. Claims 11-17 are pending in this application. Upon further consideration, the following rejections are seen as necessary.

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless --
>
> (e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371© of this title before the invention thereof by the applicant for patent.
>
> (f) he did not himself invent the subject matter sought to be patented.

3. Claims 11-14 are rejected under 35 U.S.C. 102(e and f) as being anticipated by Blaser. Blaser discloses the reaction of oximes of formula II with carbonates of formula III to yield O-substituted oximes. Applicants' generic formulae substantially overlap the generic formula of Blaser so that the reference is held to be anticipating.

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to

the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103(a).

5. Claims 11-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Blaser in view of the teaching of the American Chemical Society (ACS Symposium Series 443, 1991, Chapter 18, pages 226-235) and Hong et al. Blaser discloses the reaction of oximes of formula II with carbonates of formula III in the presence of amidine or pyridine bases and optionally in the presence of solvents to yield O-substituted oximes. Applicants' generic formulae substantially overlap the generic formula of Blaser wherein R1 and R2 may be alkyl or form a ring, n may be O and one of R3 and R5 may be hydrogen and the other alkyl. The instantly claimed invention differs from the teaching of Blaser in that additional catalysts may be used and that oxime reactants may be used which are substituted by alkyl groups of nine and ten carbons. The American Chemical Society reference discloses reacting acetone oxime and ethylene carbonate in toluene in the presence of potassium fluoride or tetramethylammonium chloride to yield the corresponding oximeglycol. The use of applicants' specific catalysts is held to be obvious in view of the fact that the use of potassium salts and basic organic nitrogen compounds are already used as catalysts in cited references. Hong et al. disclose that a similar reaction may be conducted in the absence of a solvent. It would have been prima facie obvious at the time the invention was made to start with the teaching of the cited references, to make applicants' processes using their

catalysts, oxime reactants substituted by alkyl groups including nine or ten carbon alkyl groups, to optionally not use a solvent, etc. and to expect to make O-(2-hydroxyalkyloximes). Applicants' nine and ten carbon alkyl substituted oximes are held to analogous to the oximes shown by Blaser and the other references.

The use of different, but analogous reactants in an old process does not render the process unobvious. Blaser is held to be prior art under 35 U.S.C. 102 (e and f).

6. Applicants may overcome the rejections of the claims under 35 U.S.C. 102(e) and 35 U.S.C. 103 based on art qualifying under 35 U.S.C. 102(e) by perfecting their foreign priority by submitting a certified translation of their foreign priority document.

7. No claim is allowed.

PETER O'SULLIVAN
PRIMARY EXAMINER
GROUP 1200